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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,313	04/09/2002	Sharon May Armitage	1386/5 PCT	7941

7590 12/28/2006  
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EXAMINER
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GOLDBERG, JEANINE ANNE

ART UNIT	PAPER NUMBER
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1634

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/069,313

Applicant(s)

ARMITAGE ET AL.

Examiner

Jeanine A. Goldberg

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33,35,36,38,39,41,42,44-46,48 and 54-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33,35,36,38,39,41,42,44-46,48 and 54-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to the papers filed October 10, 2006.
2. Currently, claims 33, 35-36, 38-39, 41, 44-46, 48-52, 54-69 are pending.
3. All arguments have been thoroughly reviewed but are deemed non-persuasive for the reasons which follow.
4. Any objections and rejections not reiterated below are hereby withdrawn in view of the amendments to the claims.
5. This action contains new grounds of rejection.

#### ***Claim Rejections - 35 USC § 112- Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 35-36, 54, 56, 58, 60, 65-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claims 35, 54, 56, 58, 60, 65-66 are directed to "polymeric sheet" or "cover sheet". These recitations lack antecedent basis because the independent claim from which each of the claims depends is drawn to a "transparent polymeric sheet" or a "transparent cover sheet." Appropriate correction is required.

B) Claim 36 is indefinite over the recitation "second surface" because it is unclear what second surface is being referred to.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 33, 35-36, 38, 41, 44-46, 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce (US Pat. 2,006,744, 1935) in view of Draper (US 6,007,104, December 28, 1999) and further in view of Ballard (5,709,746, January 1998).

With respect to Claim 36 and the limitation that the structure contains information as to how to use the storage structure, the inclusion of instructions is not considered to provide a patentable limitation on the claims because the instructions merely represent a statement of intended use in the form of instructions in a kit. See In re Ngai, 367 F.3d

1336, 70 U.S.P.Q.2d 1862 (Fed. Cir. 2004)(holding that an inventor could not patent known kits by simply attaching new set of instructions to that product).

Pierce teaches a finger print recorder. The finger print recorder of Pierce contains a sheet member (1) of transparent material with an adhesive coating (2). Specifically Pierce teaches the finger print recording is on a protected transparent record member by applying a piece of transparent sheet material coated with a suitable adhesive. A protective sheet of transparent material is applied to the adhesive coated side of the sheet to enclose the fingerprint thereon and provide a permanent finger print record that is an accurate reproduction of the original. Pierce suggests preserving the quality of the adhesive by keeping the adhesive applied to some surface to prevent it from collecting foreign matter. Pierce teaches that the tab may be indexed with any suitable information necessary to the recording and filing of the finger print recorder.

Pierce does not specifically teach using a backing sheet to protect the adhesive from foreign matter or a bar code for identification and recording of the fingerprint.

However, Draper teaches a form of identification material is printed on the substrate. The identification material comprises a machine readable bar code and identification number specifically to identify the biographical data, insurance information, and instructions (col. 3, lines 45-55). A device with a bar code provides a means to update all the information in an identical manner so that all pertinent information can be immediately and accurately assessed (col. 5, lines 25-33),

Moreover, Ballard teaches a self-contained fingerprint kit which comprises releasably secured sheets. Ballard teaches the release sheet is used to cover an adhesive and may be readily removed to expose the adhesive (col. 4, lines 25-35).

Therefore, it would have been prima facie obvious to the ordinary artisan at the time the invention was made to have modified the fingerprint structure taught by Pierce to allow for the identification and automated identification of the structure by adding a barcode to the structure and to have used a release liner to protect the adhesive prior to use. The ordinary artisan would have used a bar code or other non-functional printed matter on the fingerprint structure to allow for identification of the source in an easy, reliable manner. Using a bar code allows for automated identification of the structure as taught by Draper. Further, utilizing a backing sheet for the Pierce structure would protect the adhesive and allow for the use of permanent adhesive which when contacted to the base sheet could not be tampered with. The releasable sheet, taught by Ballard would be readily removed to expose the adhesive on the Pierce finger print structure and subsequently allow the security of the samples collected.

9. Claims 33, 36, 38-39, 41, 44-46, 48-52, 54-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US Pat 6,162,485, December 2000) in view of Draper (US 6,007,104, December 28, 1999).

With respect to Claim 36 and the limitation that the structure contains information as to how to use the storage structure, the inclusion of instructions is not considered to provide a patentable limitation on the claims because the instructions merely represent

a statement of intended use in the form of instructions in a kit. See In re Ngai, 367 F.3d 1336, 70 U.S.P.Q.2d 1862 (Fed. Cir. 2004)(holding that an inventor could not patent known kits by simply attaching new set of instructions to that product).

Chang teaches a finger printing system which comprises a transparent substrate with a reactive adhesive composition comprising a pressure-sensitive adhesive (col. 4, lines 1-5). The transparent substrate bearing the reactive adhesive is separated or peeled from said first substrate (col. 4, lines 41-45). This allows the visible image to be permanently protected by the transparent member which is adhered to the print-image forming area by the reactive adhesive. As seen in Figure 3A, 3B, 3C, the device comprises numerous layers for analysis. The device is a simple, defacement-proof fingerprinting system (col. 4, lines 65-66). Chang teaches that the substrate is paper (16) in Figure 2. The substrate (16) may be paper, plastic or the like (col. 9, lines 1-3)(limitations of Claim 38). Chang further teaches that the device comprises a release liner (26) which is attached by a reactive pressure-sensitive adhesive layer (28)(col. 9, lines 20-23)(limitations of Claim 41). The release liner is adhered to the substrate (16) of the security document on the non-release side of the release liner (26) by means of a permanent laminating or non-pressure sensitive adhesive (30)(col. 9, lines 22-26). The transparent film (24) along with the pressure-sensitive adhesive (28) can be easily peeled away from the release liner. The transparent film may be polyethylene, polypropylene, for example (col. 10, lines 37-40)(limitations of Claim 54). The reactive pressure sensitive adhesive is preferably coated on the release surface (col. 10, lines 46-48). The device is used to image finger prints (limitations of Claims 44-46, 48-51).

The device can contain additional absorbent materials for fingerprinting (see (32), (20), for example).

Chang does not specifically teach a bar code on the reverse surface to identify the biological sample.

However, Draper teaches a form of identification material is printed on the substrate. The identification material comprises a machine readable bar code and identification number specifically to identify the biographical data, insurance information, and instructions (col. 3, lines 45-55). A device with a bar code provides a means to update all the information in an identical manner so that all pertinent information can be immediately and accurately assessed (col. 5, lines 25-33),

Therefore, it would have been prima facie obvious to the ordinary artisan at the time the invention was made to have modified the fingerprinting system of Chang which uses identification by handwriting with a machine readable bar code of Draper. The ordinary artisan would have used a bar code or other non-functional printed matter on the fingerprint structure to allow for identification of the source in an easy, reliable manner. Using a bar code allows for automated identification of the structure as taught by Draper.

### ***Conclusion***

**10. No claims allowable over the art.**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Central Fax Number for official correspondence is (571) 273-8300.

  
**Jeanine Goldberg**  
**Primary Examiner**  
December 22, 2006